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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,686	11/17/2003	Todd Pihl	FXI03-01	5371

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EXAMINER	
DANIELS, MATTHEW J	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,686	PIHL ET AL.	
	Examiner	Art Unit	
	Matthew J. Daniels	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 25-38* is/are pending in the application.

4a) Of the above claim(s) *27,28 and 32-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 25, 26, 29-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/13/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 7-24 were cancelled and new Claims 25-38 were presented in the response filed 13 May 2005. Claims 1-6 and 25-38 are now pending.

Election/Restrictions

2. Newly submitted claims 27, 28, and 32-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These claims are drawn to a method of incorporating the draw tape into a draw tape bag, which is not considered to be a method of making a mono-axially oriented draw tape, as originally presented. The method of incorporating the tape into the bag requires heat sealing, which would require a new search for a new invention in Class 156.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27, 28, 32-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, attention is drawn to the words "greater than," used in three instances in Claim 31. While the claim appears to have support for the specific values in page 11 of the specification, there is no support for any thickness "greater than" 0.0015 inches, widths "greater than" 0.25 inches, and tensile strengths "greater than" 26 pounds. "Greater than" encompasses all values which are more than those claimed, and the Applicant's disclosure has support only for particular and limited values (See Page 11).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-6, 25, and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan (USPN 5763069). **As to Claim 1**, Jordan teaches a method for making mono-axially oriented tape, the method comprising forming a solid sheet of thermoplastic material from molten thermoplastic material (12:57-59 and 10:60-64); producing a set of tape feeds from the solid sheet of thermoplastic material; and stretching an annealing the set of draw tape feeds to orient molecules within the set of tape feeds such that the tensile strength of each tape feed is greater in a first direction than in a second direction which is substantially perpendicular to the first direction (12:29-43). **As to Claim 2**, Jordan further teaches a method wherein the step of stretching and annealing includes the step of: passing the set of tape feeds around a series of rotating temperature-controlled rollers to stretch and anneal the set of tape feeds, wherein the

series of rotating temperature-controlled rollers includes a first roller which is configured to rotate at a first rate and have a first temperature, and a second roller which is configured to rotate at a second rate that is different than the first rate and have a second temperature that is different than the first temperature (12:38-47 and 17:66-18:15). **As to Claim 3**, Jordan teaches a method wherein the step of producing the set of tape feeds includes the step of cutting the solid sheet of thermoplastic material along the first direction to produce, as the set of tape feeds, separate feeds of tape (12:19-21). **As to Claim 4**, Jordan teaches a method further comprising the step of: after the step of stretching and annealing, simultaneously winding the separate feeds of tape onto respective hubs in order to simultaneously form multiple rolls of tape (13:32-36). **As to Claim 5**, Jordan teaches a method wherein the molten thermoplastic material includes molten linear low-density polyethylene (7:22-30), and wherein the step of forming the hardened sheet of thermoplastic material includes the step of: cooling the molten linear low-density polyethylene in a bath (13: 13-1 8). **As to Claim 6**, Jordan teaches a method wherein the molten thermoplastic material includes molten linear low-density polyethylene (7:22-30) and wherein the step of forming the solid sheet of thermoplastic material further includes the step of prior to cooling, extruding the molten thermoplastic through a die that defines an elongated opening (10:47-49). **As to Claim 25**, Jordan teaches slitting (12:16-28). This would have inherently have dimensioned the tape to a size and shape suitable for use as a draw tape, meeting the claimed limitation. **As to Claim 26**, Jordan's solid sheet includes a unitary homogeneous layer (Fig. 3, Item 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 29-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan (USPN 5763069). Jordan teaches the subject matter of Claim 26. See the rejection of Claim 26 above under 35 USC 102(b). **As to Claim 29**, Jordan teaches the steps of forming the thermoplastic material, cutting, stretching, and annealing, as shown in the rejections of Claims 1-6. See the rejections of Claims 1-6 under 35 USC 102(b). Jordan teaches each of the claimed processes, and also appears to teach these processes occurring in an in-line matter as part of a continuous integrated system (Columns 11-12). Furthermore, it has been held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) and MPEP 2144.04 III. In this case, the claimed continuous integrated system is an automatic means to automate the method of Jordan, and would have been obvious to one of ordinary skill in the art at the time of the invention. **As to Claim 30**, Jordan teaches parallel knife blades forming multiple tapes (12:15-28), and therefore concurrent winding of these multiple tapes onto respective hubs would have been prima facie obvious. The automation of the winding process would have also been prima facie obvious for the same reasons as those set forth in the rejection of Claim 29. **As to Claim 31**, these limitations are interpreted to be article limitations that do not materially affect the claimed method of making the mono-axially oriented draw tape. However, Jordan teaches a width greater than 0.25 inches (12:23) and a

thickness greater than 0.0015 inches (13:39), and the tensile strength would have been inherent or obvious in that the same process is claimed.

Response to Arguments

7. Applicant's arguments filed 13 May 2005 have been fully considered but they are not persuasive. The Applicant's arguments appear to be on the following grounds:

a) Jordan does not teach a draw tape

b) Jordan's tape is not intended for use as a draw tape

c) Jordan's tape is unsuitable for use as a draw tape

8. These arguments are not persuasive for the following reasons:

a, b, c) The Applicant's intended use language and definition of draw tape are noted. However, the claimed method of making a draw tape is still anticipated by Jordan, because all of the method steps are disclosed. The Applicant correctly notes that the reference to Jordan refers to the product as "tapes" (See 14:20, for instance), and the Examiner finds no persuasive reason why these tapes could not have inherently have performed the function of draw tapes. Although Jordan is silent to this limitation, the ability to function as draw tapes was inherent in that they are made by the same method as that claimed in the instant application. The Applicant's citation of the width and thickness of Jordan's tapes is also noted (13:36-40). However, it should be noted that Jordan also teaches 8 mm (12:23), which is equal to 0.314 inches, and a thickness of 220 microns (13:36-40), which is equal to 0.00866 inches. Comparison to the claimed widths and thickness of the instant application (Claim 31) appears to contradict the Applicant's

argument that Jordan's tapes would have been unsuitable for use as a draw tape. The Examiner maintains that the method is still anticipated, and the additional limitations would have been obvious for the reasons given in the new rejections necessitated by amendment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Thursday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 7/25/05

MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER